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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,689	03/29/2004	Mitsuhiro Naito	118407	1104
25944	7590	12/20/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			MANCHO, RONNIE M	
		ART UNIT		PAPER NUMBER
		3663		

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/810,689	NAITO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ronnie Mancho	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 September 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Drawings***

1. The drawings were received on 9/28/05. These drawings are accepted.

***Claim Objections***

2. Claim 8 is objected to because of the following informalities

In claim 8, the preamble reads device, not method. The applicant is called upon to change “device” to --method-- for consistency with claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In amended claims 1, 7, 16, and 17, the applicant claims “an accessory signal”, “portion”, “portions”, and “unnecessary communication”. These limitations are indefinite.

Furthermore, the claims are not clear because there is no clear distinction between the elements or parts of the claim. Applicant has not distinguished the “the portions of the navigation device unnecessary for communication” from -- portions necessary for communication--.

It is noted that all components of the navigation device are at least necessary for communication.

The rest of the claims are also rejected for their dependence on a rejected independent claim.

Independent claims 1, 16, 17 call for “instructing, prior to initiating start-up of a navigation device, a communication portion to communicate with a server”. On the other hand, as disclosed in the specification page 7, sections 0036 and 0047, the communication portion 38 is part of the navigation device 15. Therefore, when the communication portion 38 communicates with a server, it is also interpreted that it is the navigation device 15 that communicates with the server since 38 is part of 15. Hence the limitation “instructing, prior to initiating start-up of a navigation device, a communication portion to communicate with a server” is not clear.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 7-17, 19, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamoto (US 6907255).

Regarding claim 7 (as best understood), Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40) disclose a navigation device, comprising:

a communication portion 98 that is configured to communicate with a server 86 that distributes data (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9); and a data storage portion (RAM, col. 6, lines 30-59) that stores the data that is distributed from the server, wherein when start-up of the navigation device 81 is initiated, communication with the server is executed and the distributed data is

downloaded prior to completion of start-up (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9).

Regarding claim 8, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, further comprising a controller that: initiates start up of the navigation device; starts-up the communication portion; instructs the communication portion to communicate with the server, prior to completion of start-up of the navigation device.

Regarding claim 9, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, further comprising: at least one of a display portion and a voice output portion, wherein after start-up of the navigation device is completed, data stored in the data storage portion is at least one of displayed on the display portion and voice output from the voice output portion.

Regarding claim 10, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein when an operating system starts up following initiation of start-up of the navigation device, a network driver starts up and the distributed data is downloaded, and then start-up of a device driver other than the network driver and an application program is executed.

Regarding claim 11, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein data that is pre-set is downloaded from the server.

Regarding claim 12, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion is a wireless local area network device.

Regarding claim 13, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion is a removable cellular terminal.

Regarding claim 14, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion communicates directly with the server.

Regarding claim 15, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion communicates with an information terminal, the information terminal connected to the server through a network.

Regarding claim 16, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40) disclose a navigation device, comprising:

means for instructing, prior to initiating start-up of a navigation processing portion of a navigation device, a communication portion of the communication device to communicate with a server 86 (fig. 1; col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67);

means for starting-up the communication portion 98, the communication portion connected to the navigation portion of the navigation device 81 (fig. 1; col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67);

means for communicating with the server 86 using the communication portion (fig. 1; col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67); and

means for starting-up, after the communication portion has started-up, portions of navigation device unnecessary for communication (fig. 1; col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67).

Regarding claim 17, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40) disclose a storage medium (RAM, ROM; fig. 2) ) storing a set of program instructions executable on a data processing device 91 and usable for communicating a navigation device with a server 86, the set of program instructions comprising:

instructions for instructing, prior to initiating start-up of a navigation device, a communication portion to communicate with a server (col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67);

instructions for starting-up the communication portion, the communication portion connected to the navigation device col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67);

instructions for communicating with the server using the communication portion col. 6, lines 3-7, lines 25-40; col. 9, lines 33-67); and

instructions for starting-up, after the communication portion has started-up, portions of navigation device unnecessary for communication (col. 6, lines 26-40; cols. 5, 8, 9).

Regarding claim 19, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40) disclose the navigation system according to claim 16, wherein the communication portion is connected to a wireless communication device or a removable wireless communication device.

Regarding claim 20, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 26-40) disclose the navigation system according to claim 17, wherein the communication portion is connected to a wireless communication device or a removable wireless communication device.

With regard to claim 7-17, 19, and 20 the statements of intended use or field of use, "accessory signal causing", "device starts up", "to be supplied with electric power", starting-up after", clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does.  
Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

***Response to Arguments***

7. Applicant's arguments filed 9-28-05 have been fully considered but they are not all persuasive.

The previous objection to the claims has been withdrawn in view of the amendment. However, the amendment to the method limitations are confusing as indicate in the 112 rejection above.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### Communication

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571/272/6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronnie Mancho

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Examiner  
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6/25/05

JACK KERH  
SUPERVISORY PATENT EXAMINER